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In the Supreme Court of the United States

OCTOBER TERM, 1948

No. 123

CARTER CARBURETOR CORPORATION, PETITIONER

v.

LAWRENCE C. KINGSLAND, COMMISSIONER OF PATENTS

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA

BRIEF FOR RESPONDENT IN OPPOSITION

OPINIONS BELOW

The informal memorandum opinion of the District Court of the United States for the District of Columbia appears at pp. 15–16 of the Record. The findings of fact and conclusions of law of that court (R. 17–25) are reported at 73 U. S. P. Q. 278. The opinion of the United States Court of Appeals for the District of Columbia (R. 120–121) is reported at 77 U. S. P. Q. 499.

JURISDICTION

The judgment of the Court of Appeals was entered on May 25, 1948 (R. 121–122). The peti-

tion for a writ of certiorari was filed on June 25, 1948. The jurisdiction of this Court is invoked under Section 240 (a) of the Judicial Code, as amended by the Act of February 13, 1925.

QUESTION PRESENTED

In an interference proceeding pending before him, the Examiner of Interferences deferred setting for hearing before the Primary Examiner the junior party's motion to shift the burden of proof until final hearing. The Commissioner of Patents, on the junior party's petition, ordered that a district court ruling be accepted as *prima facie* correct and that the junior party should be declared the senior party solely for the purpose of determining the order of taking testimony. The question presented is whether the Patent Office Rules of Practice, particularly Rule 124 barring appeals from decisions on motions to shift the burden of proof in interference proceedings, or the Acts of March 2, 1927 and August 5, 1939 eliminating appeals to the Commissioner in determinations of priority of invention, deprive the Commissioner of Patents of power so to act.

STATUTES AND PATENT OFFICE RULES INVOLVED

The pertinent provisions of 35 U. S. C. § 6, 52 (Rev. Stat. 481, 483, 4904); of the Act of March 2, 1927 (44 Stat. 1335); of the Act of August 5, 1939 (53 Stat. 1212) and of the Patent Office

Rules of Practice are set forth in the Appendix, *infra*, pp. 17–22.

STATEMENT

Petitioner, Carter Carburetor Corporation, owns, by assignment, the entire right, title and interest in Coffey Patent No. 2,085,351 relating to the alleged invention of a carburetor (R. 2). This patent was issued on June 29, 1937, on the Coffey application No. 679,201, filed in the Patent Office on July 6, 1933 (R. 2). On January 14, 1946, an interference (Interference No. 82,262) was declared between this patent and the pending Hunt application No. 727,648 which was filed on May 26, 1934, and which also disclosed an alleged invention for carburetors (R. 2). As required by Patent Office Rule 97, Appendix, *infra*, p. 20, the Primary Examiner forwarded to the Examiner of Interferences a statement, in which he disclosed the applications involved in the interference, arranged in inverse chronological order of the filing of the completed applications on the basis of the above dates (R. 27). As so arranged, Hunt was the junior party in the interference and consequently was required by Patent Office Rules 116 and 118 Appendix, *infra*, p. 21 to bear the burden of proof and to take his testimony first (R. 3).

On April 8, 1946, Hunt moved the Examiner of Interferences to shift the burden of proof on the ground that he was entitled to the earlier

filing date of November 14, 1931, of application No. 575,025 which he had filed jointly with Olson (R. 28). In his motion, Hunt referred to the ruling of the United States District Court for the District of Columbia in *Bendix Aviation Corp.* v. *Coe*, Civil Action No. 20,073 brought under Rev. Stat. 4915, where the court had held that the Hunt-Olson joint application had completely disclosed the subject matter of the claims involved in the Hunt-Coffey interference and that Hunt was entitled to the filing date of that application. The Examiner of Interferences dismissed Hunt's motion "without prejudice to the right of Hunt to urge at final hearing that he be given the benefit of the earlier application" (R. 28, 29, 30). In so dismissing the motion, he pointed out that the Primary Examiner had already rejected a similar motion of Hunt in the earlier interference of which the present interference was a continuation and considered that it would merely be time-consuming to set the motion for hearing, only to have it vacated if the Primary Examiner adhered to his previous position (R. 29).

Hunt then filed "Petition to the Commissioner" calling his attention to the district court ruling and praying him to "review and reverse the ruling of the Examiner of Interferences dismissing [his] motion to shift the burden of proof" (R. 31). The Assistant Commissioner on July 19, 1946, granted Hunt's petition "to the

extent indicated" (R. 35). In his decision the Assistant Commissioner recognized that Coffey was not a party to the district court action, and that that decision was not *res judicata* as to him. But, he continued, "in accordance with the settled practice, the Patent Office will accept the Court's decision as correct, unless it is shown not to be so. *Prima facie,* therefore, Hunt is entitled, in this proceeding, to the benefit of the filing date of the joint application, and the primary examiner should have accorded him the benefit of this date in setting up the interference. Hunt, therefore, should be made the senior party, without consideration of his motion to shift the burden of proof."

"As already noted, Coffey is entitled to attack the holding that Hunt is entitled to the date of the joint application. However, * * * this question should not be further considered at the interlocutory stage, but should be disposed of at final hearing" (R. 35).

The Assistant Commissioner, in subsequently denying Coffey's petition of August 1, 1946, to vacate this order, stated that "Hunt's petition was not considered as an appeal but as a petition to the supervisory authority of the Commissioner, and the action taken on the petition was based on such authority" (R. 76). He further indicated that since the district court had held that the Hunt-Olson application completely disclosed the subject matter of interference, Hunt was entitled

prima facie to the benefit of the filing date thereof (R. 76). "This date is prior to the filing of any application by Coffey disclosing the invention here in issue. Rule 116 therefore requires that Hunt be made the senior party" (R. 77). In accordance with this order, the Examiner of Interferences realigned the parties (R. 21).

Coffey on August 26, 1946, filed a motion before the Examiner of Interferences to shift the burden of proof to Hunt (R. 78–83). The Examiner of Interferences on August 30, 1946, noted this motion, and in accordance with the Commissioner's decision of July 19, 1946, deferred consideration thereof to final hearing (R. 84). Coffey on August 29, 1946, again petitioned the Commissioner to vacate his order of July 19, 1946 (R. 85–92), which petition was denied (R. 93).

Petitioner, thereupon filed a complaint "for judgment in nature of judgment for mandamus" against the Commissioner of Patents in the United States District Court for the District of Columbia. (R. 1–11). The complaint challenged the Commissioner's authority to make the order of July 19, 1946, and demanded judgment so stating. It further prayed for an order commanding the Commissioner to vacate and set aside that order and to direct the Examiner of Interferences to disregard it (R. 10). The district court, granting the judgment prayed (R. 25–26), held that the Commissioner's order "had the practical effect of shifting the burden of proof, authority for which

is denied in the applicable law and by rule of the Patent Office. The petition to shift the burden of proof was not addressed to the Commissioner in view of his supervisory authority, and the action taken thereon may not be upheld on such hypothesis" (R. 16).

On appeal, the court below reversed (R. 121–122). Pointing out that the question before it was not whether the Assistant Commissioner's action was right but whether he had authority to act at all, the court held (R. 120–121):

> * * * neither the primary examiner nor the Assistant Commissioner rendered a decision on Hunt's motion to shift the burden of proof. Moreover, even if both had rendered decisions on that motion each would have been acting within his authority. The absence of a right of appeal to the Commissioner where Rule 124 applies does not mean that he cannot exercise his supervisory authority on request. * * * The difference between the processes is much like that between appeal and certiorari. The Patent Office Rules not only do not but could not limit the Commissioner's supervisory authority. * * * The Commissioner cannot abdicate *. * * [his] statutory duty of superintendence. It is therefore immaterial that he may establish regulations "not inconsistent with law" for the conduct of proceedings in the Patent Office. R. S. § 483 as amended, 35 U. S. C. § 6.

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ARGUMENT

In this case petitioner is seeking by a "judgment in nature of judgment for mandamus" (R. 1), to set aside the order of the Commissioner of Patents[1] whereby the Commissioner in the exercise of his supervisory authority declared that for the purpose of determining the order of taking testimony, Hunt was entitled, because of the district court ruling in the *Bendix* case, *prima facie* to be the senior party in the interference proceeding. Petitioner's position, that the Commissioner's order involved improper supervision over a quasi-judicial function of a subordinate Patent Office tribunal, is predicated on the binding effect of the Patent Office Rules of Practice, particularly Rule 124, Appendix, *infra,* p. 22, barring appeals on motions to shift burden of proof, and on the Act of March 2, 1927, 44 Stat. 1335, *infra,* p. 18, and the Act of August 5, 1939, 53 Stat. 1212, *infra,* pp. 19–20, dealing with the determination of priority of invention. The decision below rejecting these contentions is, we submit, clearly correct, and hence further review by this Court is not warranted.

1. Contrary to petitioner's assumption, the Examiner of Interferences did not pass on the merits of Hunt's motion to shift the burden of proof, and the Commissioner's order of July 19, 1946,

[1] Although the order under attack was issued by the Assistant Commissioner, petitioner does not question that the Assistant Commissioner was properly performing the Commissioner's duties.

did not purport to reverse any quasi-judicial ruling of a Patent Office tribunal. As is clear from the record, the Examiner of Interferences merely declined to set Hunt's motion for hearing on the merits before the Primary Examiner, who is charged with the determination of such matters (see Patent Office Rule 122, Appendix, *infra*, pp. 21–22), and reserved the right to Hunt to raise the question again at final hearing (R. 29). And the Commissioner in his order of July 19, recognized the limited nature of the Examiner of Interferences' action. The Commissioner's order specifically indicates that it was made "without consideration of his [Hunt's] motion to shift the burden of proof," and expressly deferred decision until final hearing on the question as to the weight to be awarded the district court ruling in the *Bendix* case on the fixing of the burden of proof (R. 35). Thus, no action was taken by the Commissioner on the merits of the question as to which of the parties should bear the burden of proof in light of the district court's ruling in the *Bendix* case, a question which petitioner asserts is not subject to the Commissioner's supervision because quasi-judicial. The only matter finally determined by the Commissioner's order was that in accordance with Patent Office settled practice the ruling in the *Bendix* case should *prima facie* be accepted "as correct, unless it is shown not to be so." (R. 35). As so limited, the sole effect of the Commissioner's order is that Hunt is the senior party

to the interference for purpose of determining the order of taking testimony, a matter which is clearly non-judicial in nature.[2]

2 (a). Rev. Stat. 481, 35 U. S. C. 6, Appendix, *infra* p. 17, clearly and explicitly clothes the Commissioner of Patents with authority, and imposes upon him a mandate, to "superintend * * * *all* duties respecting the granting and issuing of patents." (Emphasis supplied). And it has long been recognized that this duty of supervision extends to all activities of lower Patent Office tribunals respecting the granting and issuing of patents and extends to rulings made by these tribunals in interference proceedings. *Wigton* v. *Coe,* 68 F. 2d 414 (App. D. C.), certiorari denied, 291 U. S. 677; *Svenson* v. *Coe,* 101 F. 2d 684, 685 (App. D. C.); *United States ex rel. American Gas-Accumulator Co.* v. *Coe,* 84 F. 2d 398 (App. D. C.); *United States ex rel. Searl* v. *Robertson,* 18 F. 2d 829 (App. D. C.), certiorari denied, 275 U. S. 532; *United States ex rel. Dwiggins* v. *Ewing,* 43 App. D. C. 204, certiorari denied, 238 U. S. 640; *Podlesak* v. *McInnerney,* 26 App. D. C. 399, 404; *In re Drawbaugh,* 9 App. D. C. 219, 240.

(b). The over-all supervisory authority vested in the Commissioner by Rev. Stat. 481, has not

[2] Since each of the parties in their preliminary statements alleged dates of invention prior to the filing date of the Hunt-Olson application, the *prima facie* seniority accorded to Hunt by the Commissioner will not have any affect ultimately on the determination of priority of invention.

been curtailed in the situation here involved, as petitioner suggests (Pet. 9, 10, 14–18), by the Patent Office Rules of Practice, particularly Rule 124, promulgated by the Commissioner. Although the Rules of Practice are binding upon the Commissioner (see *Ewing* v. *Fowler Car Co.*, 244 U. S. 1, 3–4), these Rules are promulgated pursuant to his power to establish, for the conduct of proceedings in the Patent Office, regulations "not inconsistent with law." Rev. Stat. 483, 35 U. S. C. 6, Appendix, *infra* p. 17. And it is obvious that any rule by which the Commissioner undertook expressly to remove any duty respecting the granting and issuing of patents entirely from under his supervision would be inconsistent with law. As pointed out below (R. 121), "the Commissioner cannot" by the promulgation of Rules of Practice "abdicate * * * [his] statutory duty of superintendence."[3]

The view that the Commissioner retained supervisory authority over his subordinates' activities without regard to the nature of these activities or whether an appeal to him therefrom would lie under the Rules of Practice has been consistently adhered to by the Patent Office and approved by the courts. This view is based on the recognized

[3] Were the Commissioner precluded from supervising the work of the patent and trademark examiners and the examiners of interferences the greater part of which is quasi-judicial in nature, the Commissioner would have supervision over only a relatively minor part of the activities of the Patent Office.

fact that the Commissioner's duties respecting the granting and issuing of patents are dual in nature; he acts as a supervisor over his subordinates' activities, and he sits as an appellate tribunal in matters in regard to which the Rules of Practice or pertinent statute provide for an appeal to him as of right. See McCrady, *Patent Office Practice* (2d Ed. 1946) p. 249. As stated below, "the difference between the two processes is much like that between appeal and certiorari" (R. 121). Hence, it has long been accepted that the Commissioner acting in his supervisory capacity may, notwithstanding the absence of a right to appeal, correct, on his own initiative or on the petition of the party affected, a clear error of a lower Patent Office tribunal, committed while ruling on a quasi-judicial matter assigned to it by rule or statute. See, *e. g., Sobey* v. *Holsclaw,* 28 App. D. C. 65, certiorari denied, 203 U. S. 594; *Wigton* v. *Coe,* 68 F. 2d 414 (App. D. C.), certiorari denied, 291 U. S. 677; *United States ex rel. Dwiggins* v. *Ewing,* 43 App. D. C. 204, certiorari denied, 238 U. S. 640; *Podlesak* v. *McInnerney,* 26 App. D. C. 399; *Moore* v. *United States ex rel. Chott,* 40 App. D. C. 591, writ of error dismissed, 237 U. S. 197; *Goss* v. *Scott,* 1901 C. D. 548; *Ex parte Knudsen,* 1895 C. D. 29; *Ex parte Pledger,* 1910 C. D. 124; *Raulet* v. *Adams,* 1905 C. D. 55; *Ex parte Cady,* 1916 C. D. 57; *Ex parte Hackett,* 1921 C. D. 63; *Ex parte Mattlet,* 1926 C. D. 62; cf.

McCrady, *Patent Office Practice* (2d Ed. 1946), p. 250.

(c) Nor does the Act of March 2, 1927, *infra*, pp. 18–19, or the Act of August 5, 1939, *infra*, pp. 19–20, deprive the Commissioner of supervisory authority over his subordinate's determinations as to priority of invention, which petitioner claims was involved in the Commissioner's order. Both these Acts were concerned with the Commissioner only as an appellate tribunal, and did not restrict his supervisory authority. Prior to the Act of March 2, 1927, an applicant could take an appeal to the Commissioner from the decision of the board of examiners in chief reviewing the earlier decision of a Primary Examiner as to priority of invention. The Act of March 2, 1927, repealed Rev. Stat. 4910 and amended Rev. Stat. 4904 so as to eliminate appeals as of right to the Commissioner. Instead, it created a board of appeals of which the Commissioner is a member and provided that that board was to be the appellate tribunal within the Patent Office for the review and determination of questions as to priority of invention. See Appendix, *infra*, p. 18. The Act of August 5, 1939, did away with appeals within the Patent Office and established a board of three examiners of interference to determine the question of priority of invention. The Act further provided "and the Commissioner may issue a patent to the party who is adjudged the prior inventor." Appendix, *infra*, p. 20. Thus, as far as the Commissioner's duties are concerned, both

Acts together merely eliminate a right of appeal to him without affecting his supervisory authority over his subordinates' activities, including those activities dealt with in these Acts. See cases cited, *supra*, pp. 12–13.[4]

3. There are additional reasons supporting the decision below. The question as to who is to bear the burden of proof becomes important only when the evidence is evenly balanced. If, as is usually the situation when all the evidence is in, there is a preponderance favoring one party as against the other, all questions as to burden of proof cease to have any practical significance. The possibility of an ultimate outcome favorable to petitioner renders premature his complaint that he has been injured by the Commissioner's order, particularly in view of the fact that the only effect of that order is to require him to take testimony first.

[4] *Butterworth* v. *United States ex rel. Hoe*, 112 U. S. 50, relied on by petitioner (Pet. 10–11, 18–20) is clearly distinguishable and does not govern the present case. The *Hoe* case related to the right of the Secretary of Interior to review a decision of the Commissioner of Patents and the statute there involved merely stated that the Commissioner was to act under the direction of the Secretary; it did not charge the latter with superintending all duties of the Commissioner. Further, this Court in the *Hoe* case relied heavily on the fact that the statute there involved provided for judicial review of the Commissioner's action. The statutes involved here make no such provision for judicial review of decisions of the primary examiner or of the examiner of interferences on such interlocutory or formal matters in interferences, as determining which party is to take testimony first, or for that matter, fixing the burden of proof.

If Coffey is in fact the first inventor, he must be able to prove it independently of the testimony introduced by Hunt. For this reason, the mere requirement of the Commissioner that Coffey take testimony first does not cause him such irreparable injury as will sustain the relief sought. Cf. *Myers* v. *Bethlehem Shipbuilding Corp.*, 303 U. S. 41, 50–51.

Moreover, when the question as to burden of proof is determined at final hearing, it will be reviewable by the courts in the manner regularly provided, that is, by appeal from an award of priority or by action under Rev. Stat. 4915. Accordingly, judicial intervention by way of mandatory injunction at this interlocutory state of Patent Office proceedings is unwarranted. Cf. *United States ex rel. American Gas-Accumulator Co.* v. *Coe,* 84 F. 2d 398 (App. D. C.); *United States ex rel. Searl* v. *Robertson,* 18 F. 2d 829 (App. D. C.), certiorari denied, 275 U. S. 532; *United States ex rel. Dwiggins* v. *Ewing,* 43 App. D. C. 204, certiorari denied, 238 U. S. 640; *Moore* v. *United States ex rel. Lindmark,* 33 App. D. C. 597.

CONCLUSION

The decision below is clearly correct, and there is no conflict with any applicable decision of this

Court. The petition for a writ of certiorari should therefore be denied.

Respectfully submitted.

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JULY 1948.

APPENDIX

1. 35 U. S. C. 6 (Rev. Stat. 481, 483) provides as follows:

> The Commissioner of Patents, under the direction of the Secretary of Commerce, shall superintend or perform all duties respecting the granting and issuing of patents directed by law; and he shall have charge of all books, records, papers, models, machines, and other things belonging to the Patent Office. He may, subject to the approval of the Secretary of Commerce, from time to time establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent Office.

2. Rev. Stat. 4904 provides as follows:

> Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be, and shall direct the primary examiner to proceed to determine the question of priority of invention. And the Commissioner may issue a patent to the party who is adjudged the prior inventor, unless the adverse party appeals from the decision of the primary examiner, or of the board of examiners-in-chief, as the case may be, within such time, not less than twenty days, as the Commissioner shall prescribe.

3. Act of March 2, 1927 (44 Stat. 1335) in pertinent part provides as follows:

> SEC. 3. That section 482 of the Revised Statutes of the United States be amended to read as follows:
>
> "SEC. 482. The examiners in chief shall be persons of competent legal knowledge and scientific ability. The Commissioner of Patents, the first assistant commissioner, the assistant commissioner, and the examiners in chief shall constitute a board of appeals, whose duty it shall be, on written petition of the appellant, to review and determine upon the validity of the adverse decisions of examiners upon applications for patents and for reissues of patents and in interference cases. Each appeal shall be heard by at least three members of the board of appeals, the members hearing such appeal to be designated by the commissioner. The board of appeals shall have sole power to grant rehearings."
>
> SEC. 4. That section 4904 of the Revised Statutes of the United States be amended by striking out from the last sentence thereof the words "or of the board of examiners in chief, as the case may be."
>
> * * * * *
>
> SEC. 6. That section 4910 of the Revised Statutes of the United States be, and the same is hereby, repealed.
>
> * * * * *
>
> SEC. 8. That section 4911 of the Revised Statutes of the United States be amended to read as follows:
>
> "SEC. 4911. If any applicant is dissatisfied with the decision of the board of appeals, he may appeal to the Court of Appeals of the District of Columbia, in which case he waives his right to proceed under

section 4915 of the Revised Statutes. If any party to an interference is dissatisfied with the decision of the board of appeals, he may appeal to the Court of Appeals of the District of Columbia, provided that such appeal shall be dismissed if any adverse party to such interference shall, within twenty days after the appellant shall have filed notice of appeal according to section 4912 of the Revised Statutes, file notice with the Commissioner of Patents that he elects to have all further proceedings conducted as provided in section 4915 of the Revised Statutes. Thereupon the appellant shall have thirty days thereafter within which to file a bill in equity under said section 4915, in default of which the decisions appealed from shall govern the further proceedings in the case. If the appellant shall file such bill within said thirty days and shall file due proof thereof with the Commissioner of Patents, the issue of a patent to the party awarded priority by said board of appeals shall be withheld pending the final determination of said proceeding under said section 4915."

4. Act of August 5, 1939 (53 Stat. 1212) in pertinent part provides as follows:

SEC. 1. That section 4904 of the Revised Statutes (U. S. C., title 35, sec. 52) be amended to read as follows:

"Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be, and shall direct a board of three examiners of interferences to proceed to determine the question of priority

of invention. And the Commissioner may issue a patent to the party who is adjudged the prior inventor."

* * * * *

SEC. 3. That section 4911 of the Revised Statutes (U. S. C., title 35, sec. 59a) be amended by changing the words "Board of Appeals" in the second sentence to read "board of interference examiners", and by canceling the last sentence of said section.

5. The Patent Office Rules of Practice read as follows:

97. When an interference is found to exist and the applications are prepared therefor, the primary examiner shall forward to the interference division the files and drawings; notices of interference for all the parties (as specified in rule 103) disclosing the name and residence of each party and those of his attorney or agent, and of any assignee, and, if any party be a patentee, the date and number of the patent; the ordinals of the conflicting claims and the title of the invention claimed; and the issue, which shall be clearly and concisely defined in so many counts or branches as may be necessary in order to include all interfering claims. Where the issue is stated in more than one count the respective claims involved in each count shall be specified. The primary examiner shall also forward a statement disclosing the applications involved in interference, fully identified, arranged in the inverse chronological order of the filing of the completed applications, and also disclosing the issue or issues and the ordinals of the conflicting claims, the name and residence of any assignee, and the names and

residences of all attorneys or agents, both principal and associate.

* * * * *

116. The parties to an interference will be presumed to have made their inventions in the chronological order in which they filed their completed applications for patents clearly disclosing same; and the burden of proof will rest upon the party who shall seek to establish a different state of facts.

The termination of the interference by dissolution under rule 122 without an award of priority shall not disturb this presumption, and a party enjoying the status of a senior party with respect to any subject-matter of his application shall not be deprived of any claim to such subject-matter solely on the ground that such claim was not added to the interference by amendment under Rule 109.

* * * * *

118. Times will be assigned in which the junior applicant shall complete his testimony in chief, and in which the other party shall complete the testimony on his side, and a further time in which the junior applicant may take rebutting testimony; but he shall take no other testimony. If there be more than two parties to the interference, the times for taking testimony will be so arranged that each shall have an opportunity to prove his case against prior applicants and to rebut their evidence, and also to meet the evidence of junior applicants.

* * * * *

122. Motions to dissolve an interference (1) alleging that there has been such informality in declaring the same as will pre-

clude the proper determination of the question of priority of invention, or (2) denying the patentability of an applicant's claim, or (3) denying his right to make the claim, or (4) if the interference involves a design patent or an application, alleging that there is no interference in fact and also motions to shift the burden of proof, should contain a full statement of the grounds relied upon and should, if possible, be made within the time fixed by the examiner of interferences, not less than thirty days, after the statements of the parties have been received and approved. Such motions and all motions of a similar character, if in the opinion of the examiner of interferences they be in proper form, will be heard and determined by the primary examiner, due notice of the day of hearing being given by the office to all parties. If in the opinion of the examiner of interferences the motion be not in proper form, or if it be not brought within the time specified and no satisfactory reason be given for the delay, it will not be considered and the parties will be so notified.

At the hearing on a motion to dissolve an interference between an application and a patent, the prior art of record in the patent file shall be referred to for the purpose of construing the issue. The matter raised on a motion to shift the burden of proof may be reviewed at final hearing.

124. No appeal will be permitted from a decision rendered on a motion brought under the provisions of rules 109 and 122.

Appeals may be taken directly to the Commissioner from decisions on such other motions as, in his judgment, should be appealable.

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CHARLES ELMORE

IN THE

Supreme Court of the United States

No. 123.

October Term, 1948.

CARTER CARBURETOR CORPORATION,
Petitioner,

v.

LAWRENCE C. KINGSLAND, Commissioner of Patents,
Respondent.

PETITION FOR REHEARING OF THE PETITION OF CARTER CARBURETOR CORPORATION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA.

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Petitioner,

v.

LAWRENCE C. KINGSLAND, COMMISSIONER OF PATENTS,

Respondent.

PETITION FOR REHEARING OF THE PETITION OF CARTER CARBURETOR CORPORATION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA.

To the Honorable the Chief Justice of the United States and the Associate Justices of the Supreme Court of the United States:

Your petitioner, Carter Carburetor Corporation, prays for a rehearing of its petition for a writ of certiorari to the United States Court of Appeals for the District of Columbia, which was denied by an order of this Court made on October 11, 1948. Said petition sought a review of the judgment of that Court entered May 25, 1948 which reversed the judgment of the District Court of the United States for the District of Columbia in Civil Action No. 37782, Carter Carburetor Corporation, Plaintiff, v. Casper W. Ooms, Commissioner of Patents, Defendant, for the latter of whom Lawrence C. Kingsland was later substituted.

As the ground for its petition for rehearing, petitioner states:

On June 29, 1948, four days after the petition for certiorari was filed and before the aforesaid order denying the petition for certiorari was entered, an order of the Commissioner of Patents was published in a Supplement to Official Gazette of the United States Patent Office. That order gave notice that the Patent Office proposed to issue rules and regulations relating to proceedings before it in patent cases and contained a Proposed Revision of Patent Rules. Among such proposed rules is 31.3 which is:

> "31.3 *Suspension of rules.* In an extraordinary situation, when justice requires, any requirement of these rules which is not a requirement of the statutes may be suspended or waived by the Commissioner in person on petition of the interested party, subject to such other requirements as may be imposed."

The proposal of that rule is a circumstance of substantial or controlling effect. It manifests the intention of the Commissioner of Patents to carry forward against all persons having relations with the Patent Office the unlimited and unrestrained power and jurisdiction which the Court of Appeals conferred upon him by giving to R. S. § 481 (35 U. S. C. § 6) dominance not only over the rules of the Patent Office but, as well, over other patent statutes.

In its opinion the Court of Appeals for the District of Columbia said in part (R. 119-121):

> "The absence of a right of appeal to the Commissioner where Rule 124 applies does not mean that he cannot exercise his supervisory authority on request. • • • The difference between the two processes is much like that between appeal and certiorari. The Patent Office Rules not only do not but could not limit the Commissioner's supervisory authority. For R. S. § 481

as amended, 35 U. S. C. § 6, provides that '*The Commissioner of Patents, under the direction of the Secretary of Commerce, shall superintend or perform all duties respecting the granting and issuing of patents* • • •.' The Commissioner cannot abdicate this statutory duty of superintendence. • • •" (Emphasis supplied.)

In arriving at that conclusion, it is believed to be obvious that the Court considered R. S. § 481 not only *in vacuo* but without regard to its legislative history,* to other patent statutes, or to the effect upon the construction of that statute of the words thereof—"under the direction of the Secretary of Commerce" and "directed by law."

As a consequence, it is submitted that if the construction and dominant effect given to R. S. § 481 (35 U. S. C. § 6) by the erroneous decision of the said Court is permitted by this Court to stand and remain as a buttress and support for such practice as is contemplated by the proposed rule, it will give color of legality to a grant of power to the Commissioner which trenches upon the fundamental principles of our system of Government to the detriment and prejudice of the public at large.

Wherefore, your petitioner respectfully prays that a rehearing be granted.

HUGH M. MORRIS,
GILBERT P. RITTER,
Attorneys for Petitioner.

GEORGE R. ERICSON,
Of Counsel.

Dated: October 25, 1948.

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* Patent Act of 1836 (5 Stat. 117 § 1); Consolidated Patent Act of 1870 (16 Stat. 198 § 7); Congressional Globe Vol. 43, Part 4, pp. 2855-2856; Congressional Globe Vol. 43, Part 5, pp. 2679-2680; Congressional Record Vol. 2, Part 1, 43d Congress, First Session, pp. 819-820.

We do hereby certify that the foregoing petition for rehearing is presented in good faith and not for delay and, also, that the petition is restricted to the grounds specified in Paragraph 2 of Rule 33 of this Court.

HUGH M. MORRIS,
GILBERT P. RITTER,
Attorneys for Petitioner.

Dated: October 25, 1948.

CERTIORARI DENIED